

REMARKS

Claim Status

Claims 1-4 are pending, with claim 1 being the sole independent claim. Claim 1 has been amended. No new matter has been added by way of the above amendment. Reconsideration of the application, as amended, is respectfully requested.

Overview of the Office Action

Claims 1-4 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Publication No. 2001/0054010 ("*Bernabeo*").

Applicants have carefully considered the Examiner's rejection, and the comments provided in support thereof, and respectfully disagree with the Examiner's analysis. For the reasons which follow, it is respectfully submitted that all claims of the present application are patentable over the cited reference.

Summary of Subject Matter Disclosed in the Specification

The following descriptive details are based on the specification. They are provided only for the convenience of the Examiner as part of the discussion presented herein, and are not intended to argue limitations which are unclaimed.

The present invention relates to a method for providing an individual device code for an electronic device that is required for at least the initial commissioning of the device, whereby the device is inoperable without the input of the individual device code (see pg. 1, paragraph 1 of the specification).

In accordance with the method of the invention, a device number and the appropriate device code for a device to be delivered are initially stored in a database. In this case, the manufacturer of the device performs this initial step. However, the device may be delivered to a distribution center where the initial step is performed. Subsequently, the device is delivered, whereby the device as a rule is delivered directly to an end customer, but can also be first delivered to a further processing site or an intermediary site, such as a retailer. At this point, the device is not yet operable because the device code is required for at least the first commissioning of the device. However, it is still not possible to read the device code from the database because the input of a code number is a prerequisite for readout of the device code (see pg. 4, 5th paragraph of the specification).

Descriptive Summary of the Prior Art

Bernabeo discloses an “electronic purchasing system ... which facilitates transactions between vendors and purchasers” (see paragraph [0013], lines 1-4). *Bernabeo* states, “a purchaser [is allowed] to complete a part of a purchase transaction in cyberspace, and a remainder of the transaction in real space”. *Bernabeo* also states, “electronic sales codes and corresponding electronic redemption *Bernabeo* codes are generated in response to an electronic commerce transaction between a purchaser and a vendor for a ‘good’ (i.e., a good or service, e.g., goods, tickets, admittance to an event, hotel reservations, etc)” (see paragraph [0014], lines 7-12). *Bernabeo* teaches that the “electronic redemption code is transmitted to an electronic storage device capable of storing the electronic redemption code, and [that] the electronic sales code is transmitted to a server accessible to an electronic redemption device and is marked as valid” (see paragraph [0014], lines 12-16). An electronic redemption device is located at a physical extension of the vendor (i.e., at a ‘real-world’ store or forum where the good is

available) (see paragraph [0014], lines 16-18). *Bernabeo* further states, the “user may transport the electronic redemption code in the electronic storage device or transmit the electronic redemption code to another electronic storage device to facilitate transporting the electronic redemption code” (see paragraph [0014], lines 19-22).

Bernabeo (paragraph [0030]) teaches an embodiment in which a purchaser 202 desires access to a movie showing at a theater 204. *Bernabeo* (paragraph [0030], lines 4-6) states, “the purchaser 202 accesses movie date and time information using a wireless device 203, e.g. a Web-enabled wireless telephone”. *Bernabeo* (paragraph [0030], lines 6-9) teaches that the movie date and time information is accessible through a remote server 206A located at a business entity 206, e.g. via a website. *Bernabeo* (paragraph [0030], lines 9-15) states, “the purchaser 202 establishes contact with the remote server 206A through wireless communication via a cellular provider 208 and the Internet 210. After the purchaser 202 has identified the movie he would like to attend, the purchaser 202 produces purchasing information for purchasing admittance to the movie showing on the desired date at the desired time to the business entity 206”. *Bernabeo* (paragraph [0030], lines 15-20) states, “upon purchasing admittance, the business entity supplies the purchaser 202 with a redemption code. In addition, upon purchase, the business entity 206 transfers information corresponding to the redemption code, e.g. a corresponding sales code, to the theater 204 via the Internet 210”. Thus, paragraph [0030] of *Bernabeo* relates to the showing of a movie in a theater. However, paragraph [0030] has nothing to do with a device that is inoperable without inputting a device code for at least one time.

Patentability of the Independent claims over the Prior art

The Examiner contends (pg. 2, paragraph 4 of the Office Action) that:

Bernabeo ... discloses ... providing device codes (redemption code) for [a] device before it is **commissioned**¹ (i.e. **given to a purchaser for use for the first time**) see Par. 0028. And further, the Bernabeo discloses the redemption code being given to the purchaser used for admittance (to put in active or usable state) see Par. 0030. (Emphasis Added)

The Examiner's definition of "commission" states that "commission" is when something is in "an active service" or "in use or in usable condition". Based on this reasoning, the Examiner has concluded that "a first commissioning of a device" means "given to the purchaser for use for the first time". Applicants respectfully assert that this meaning is contrary to Applicants' claimed meaning of the word commission.

The meaning of the word "commissioning" is described at pg. 1, paragraph 1 of Applicants' originally filed application, i.e., the device is not operable without the input of the device code. Such an interpretation is also supported by the dictionary.com definition, the same source cited by the Examiner in the Office Action, which defines commission as "in use or in usable condition". However, concluding that "given to the purchaser for use for the first time" is the claimed commissioning, as the Examiner contends, is contrary to the meaning set forth in Applicants' specification and the meaning of the term within the context of amended claim 1. A device given to a purchaser for use the first time does not indicate whether the device is even operable. Thus, *Bernabeo* fails to teach a device that is inoperable without providing the individual device code to the device at least once, as recited in amended independent claim 1.

In order to make this distinction of the invention over *Bernabeo* even clearer and more explicit, claim 1 has been revised herein to include the following features.

1. The claimed method is specified in the preamble as being for preventing unauthorized use of an electronic device.

2. A device number and an appropriate device code are electronically stored in a

database, and the appropriate device code is specified as being required to operate the device, at least for the first commissioning of the device.

3. The device is rendered to be inoperable until it receives the appropriate device code.

4. The device is delivered to a further processing site.

5. Electronic read out from the database the appropriate device code stored in conjunction with the device number is enabled only when a selected code number is provided in conjunction with the device number. The appropriate device code which has been read out from the database is then usable to operate the device for at least the first commissioning of the device.

Regarding above-listed feature no. 1, *Bernabeo* is directed to an “electronic purchasing system ... which facilitates transactions between vendors and purchasers,” not to a method for preventing unauthorized use of an electronic device.

Regarding above-listed feature no. 2, the appropriate device code is specified as being required to operate the device. In contrast, the redemption code disclosed in *Bernabeo* is not comparable to the claimed device code. Since it is not even provided to the device, it cannot control operation of the device. To the contrary, with use of the *Bernabeo* invention it is possible to operate a stolen device without a redemption code. More specifically, *Bernabeo* teaches that the redemption code relates to whether the device has been paid for. In the method disclosed in *Bernabeo*, the first step is for a purchaser to pay a certain amount of money to the vendor or to make a reservation for goods (see paragraph [0026], lines 1-17). The second step is to deliver a redemption code to a storage designated to the purchaser (see paragraph [0026], lines 18-22). In a third step, the purchaser goes to a “physical” store, i.e., a “brick-and-mortar” store, to pick up the purchased goods (see paragraph [0026], lines 22-26). By using the redemption code, the store can verify whether payment for the requested goods or services has already been made (see

paragraph [0026], lines 26-30). If a payment has been made, then the store delivers the goods to the end customer (see paragraph [0026], lines 32-34). Thus, *Bernabeo* teaches that the redemption code is only requested by a store to check if payment for the device has been made prior to handing the device to a purchaser. Thus, the redemption code has nothing to do with inhibiting operation of the device. However, the device of amended claim 1 cannot be operated without providing the individual device code to the device at least once.

Regarding above-listed feature no. 3, there is nothing in *Bernabeo* to even hint at rendering the device to be inoperable until it receives the appropriate device code.

Skipping to above-listed feature no. 5, *Bernabeo* does not disclose enabling electronic read out from the database of the appropriate device code stored in conjunction with the device number only when a selected code number is provided in conjunction with the device number. Of course, *Bernabeo* is also completely silent on using the appropriate device code which has been read out from the database to operate the device for at least the first commissioning of the device.

In view of the foregoing, Applicants respectfully assert that *Bernabeo* fails to anticipate amended independent claim 1. Therefore, reconsideration and withdrawal of the rejection under 35 U.S.C. §102 are in order.

Moreover, due to the fundamental above-discussed differences between the present claimed invention and *Bernabeo*, it is clear that the present invention is patentable over this reference under 35 U.S.C. §103.

Dependent Claims

In view of the patentability of independent claim 1, for the reasons set forth above, dependent claims 2-4 are all patentable over the prior art. In addition, these claims include features which serve to even more clearly distinguish the present invention over the prior art.

For example, dependent claim 2 recites that "the appropriate device code is stored in the device." This is explained in text spanning pages 6 and 7 of the specification. Of course, no such feature is disclosed, taught or even hinted at in *Bernabeo*.

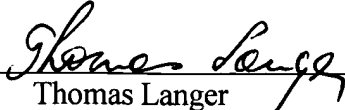
Conclusion

Based on all of the above, it is respectfully submitted that the present application is now in proper condition for allowance. Prompt and favorable action to this effect and early passing of this application to issue are respectfully solicited.

Should the Examiner have any comments, questions, suggestions or objections, the Examiner is respectfully requested to telephone the undersigned in order to facilitate reaching a resolution of any outstanding issues.

It is believed that no fees or charges are required at this time in connection with the present application. However, if any fees or charges are required at this time, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,
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